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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/545,072 04/07/00 LIN

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EXAMINER
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HM22/0511

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KUBEL, K. A.	
ART UNIT	PAPER NUMBER

1638

DATE MAILED:

05/11/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

# Office Action Summary

Application No.

09/545,072

Applicant(s)

LIN ET AL.

Examiner

Anne Kubelik

Art Unit

1638

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED. (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 07 April 2000.
- 2a) ☐ This action is FINAL.
- 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-39 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☒ Claims 1-39 are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

- 15) ☐ Notice of References Cited (PTO-892)
- 16) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 17) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_

- 18) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 19) ☐ Notice of Informal Patent Application (PTO-152)
- 20) ☐ Other: \_\_\_\_\_

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***Election/Restrictions***

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-13 and 15-22, drawn to a nucleic acid encoding an SSE polypeptide and *Agrobacteria* and plants comprising that nucleic acid under the control of plant-expressible promoters, classified in class 800, subclass 281, for example.
- II. Claims 14 and 32, drawn to non-*Agrobacterium* bacterial cells comprising a nucleic acid encoding an SSE polypeptide and a method of producing an SSE polypeptide via gene expression under the control of prokaryotic promoters, classified in class 435, subclass 71.2, for example.
- III. Claims 23-26, drawn to an expression vector for antisense SSE RNA and plants comprising that expression vector, classified in class 800, subclass 286, for example.
- IV. Claims 27-31 and 33, drawn to an SSE polypeptide, classified in class 530, subclass 370, for example.
- V. Claims 34-35, drawn to an antibody against an SSE polypeptide, classified in class 530, subclass 387.1, for example.
- VI. Claim 36, drawn to a method of isolating an SSE gene via hybridization, classified in class 435, subclass 6, for example.
- VII. Claims 37-39, drawn to a method of isolating an SSE gene via PCR, classified in class 435, subclass 91.2, for example.

The inventions are distinct, each from the other, because:

Inventions I-III are unrelated to invention IV. Inventions are unrelated if it can be shown

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that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case, the different inventions have different modes of operation and different functions. The first group of inventions is distinct from invention IV because the former requires isolated DNA and methods for plant or bacterial transformation and regeneration not required by the latter, while the latter requires isolated proteins not required by the former. Furthermore, the protein of the invention IV could be made by a process other than the expression of the gene of invention I, such as chemical synthesis or purification from the natural source, and the DNA of invention I may be used for processes other than the production of protein, such as a nucleic acid hybridization assay.

Inventions I, II and III are unrelated to each other. Invention III requires antisense constructs and antisense RNA expression, not required by inventions I and II, which require sense constructs not required by invention III. Inventions I and III require plant-expressible promoters and methods of plant transformation and regeneration not required by invention II, and invention II requires prokaryotic-expressible promoters and methods of fermentation and bacterial cell culture not required by inventions I and III.

The protein of invention IV is unrelated to the antibody of invention V. They are distinct inventions because they are physically and functionally distinct chemical entities, and because the protein can be used in another and materially different process from the use for production of the antibody, such as isolation of proteins that interact with the SSE polypeptide *in vivo*.

Inventions I, VI and VII are unrelated to each other. The different inventions have different modes of operation, different functions and different effects. The method of invention

VI of obtaining a nucleic acid by hybridization requires DNA probing techniques not required by inventions I or VI. Invention VI requires primers and DNA amplification methods not required by inventions I or VI. Lastly, invention I requires full-length SSE genes and methods of plant transformation and regeneration not required by inventions VI or VII.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, fields of search, and classification, restriction for examination purposes as indicated is proper.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Anne R. Kubelik, whose telephone number is (703) 308-5059. The examiner can normally be reached on Monday through Friday, 8:15 am - 4:45 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Paula Hutzell, can be reached on (703) 308-4310. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 308-4242 for regular communications and (703) 308-4242 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0196.

Anne R. Kubelik, Ph.D.  
May 7, 2001

DAVID T. FOX  
PRIMARY EXAMINER  
GROUP 480-1638

*David 24*